

Appl. No. 10/699,507
Amended May 14, 2008
Reply to Decision on Rehearing dated March 19, 2008

REMARKS

In response to the Decision on Rehearing dated March 19, 2008 in which the Board entered new grounds of rejections to Claims 39-45 in connection with the subject application, Applicants have amended the claims, which when considered with the following remarks, is deemed to place the present application in condition for allowance. Favorable consideration and allowance of all pending claims is respectfully requested. The amendments to the claims have been made in the interest of expediting prosecution of this case. Applicants reserve the right to prosecute the same or similar subject matter in this or another application.

Claims 39-45 are under examination in this application. By this Amendment, Claim 39 has been amended to further define the invention and finds support throughout the specification, e.g., page 20, line 13 through page 23, line 9. Applicants respectfully submit that no new matter has been added to this application. Moreover, it is believed that the claims as presented herein place the application in condition for allowance.

The Board has rejected Claims 39-42 under 35 U.S.C. §103(a) as being unpatentable over the combination of Kolosov et al., O'Rear and *The Condensed Chemical Dictionary*.

In the Decision on Rehearing, the Board maintains [emphasis in original]:

Kolosov does not expressly disclose that the lubricant compositions contain a *minor amount* of at least one lubricating oil additive. However, O'Rear discloses that finished lubricants, such as those for automobiles and diesel engines, consist of two general components: a lube base oil and additives. O'Rear, para. [0002]. The additives in the finished lubricants disclosed in O'Rear are said to be used in amounts that are known to those of skill in the art, preferably about 0.1 to about 40 weight percent of the final lube oil product. O'Rear, para. [0046]. In addition, "additive" by definition means any substance incorporated into a base material, usually in low concentrations, to perform a specific function, e.g., antioxidants, stabilizers, preservatives,

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thickeners, and viscosity-index improvers. *The Condensed Chemical Dictionary* at 20.

Based on the record before us, we find that one of ordinary skill in the art would have reasonably expected the lubricant compositions disclosed in Kolosov, comprising a lubricant and an additive, to contain a major amount of a base oil and a minor amount of an additive.

The high throughput system disclosed in Kolosov may be used to measure numerous properties, including viscosity, thermal degradation, aging characteristics, and agglomeration or assemblage of molecules. Kolosov, para. [0065]. We find that one of ordinary skill in the art would have found these properties useful in determining the storage stability of lubricating oil compositions.

Nowhere in Kolosov et al., O'Rear and *The Condensed Chemical Dictionary*, either alone or in combination, is there any disclosure or suggestion of a system for screening lubricant performance, under program control, which comprises, *inter alia*,

"c) means for measuring a first storage stability measurement of the lubricating oil composition sample moved to the testing station and for transferring said first storage stability measurement to a computer controller, wherein said computer controller is operatively connected to the means for individually moving the test receptacles, and further wherein the means for measuring the first storage stability measurement is carried out in the absence of heating each lubricating oil composition sample;

d) means for measuring a second storage stability measurement of the lubricating oil composition sample moved to the testing station and for transferring said second storage stability measurement to the computer controller, and wherein the means for measuring the second storage stability measurement is carried out after each lubricating oil composition sample is heated to a predetermined temperature for a predetermined time; and

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e) means for comparing said second storage stability measurement to said first storage stability measurement of each lubricating oil composition sample to obtain storage stability data for each sample" as presently recited in amended Claim 39.

Rather, as acknowledged by the Board, Kolosov et al. simply disclose a high throughput system which may be used to measure numerous properties, including viscosity, thermal degradation, aging characteristics, and agglomeration or assemblage of molecules. Accordingly, there is no disclosure or suggestion in Kolosov et al. of the claimed system. O'Rear and *The Condensed Chemical Dictionary* certainly do not cure and are not cited as curing the deficiencies of Kolosov et al. In contrast, O'Rear is cited for its disclosure of additives in finished lubricants which are said to be used in amounts that are known to those of skill in the art, while *The Condensed Chemical Dictionary* is cited for its definition of the term "additive" as being any substance incorporated into a base material, usually in low concentrations, to perform a specific function. Accordingly, nothing in Kolosov et al., O'Rear and *The Condensed Chemical Dictionary* would lead one skilled in the art to combine these disclosures and arrive at a system for screening lubricant performance, under program control, which comprises, *inter alia*, "c) means for measuring a first storage stability measurement of the lubricating oil composition sample ... wherein the means for measuring the first storage stability measurement is carried out in the absence of heating each lubricating oil composition sample ... d) means for measuring a second storage stability measurement of the lubricating oil composition sample moved to the testing station ... wherein the means for measuring the second storage stability measurement is carried out after each lubricating oil composition sample is heated to a predetermined temperature for a predetermined time ... and e) means for comparing said second storage

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stability measurement to said first storage stability measurement of each lubricating oil composition sample to obtain storage stability data for each sample" as presently recited in amended Claim 39.

For the foregoing reasons, amended Claims 39-42 are believed to be non-obvious, and therefore patentable, over the combination of Kolosov et al. with O'Rear and *The Condensed Chemical Dictionary*. Accordingly, withdrawal of the rejection under 35 U.S.C. §103(a) is respectfully requested.

The Board has rejected Claim 43 under 35 U.S.C. §103(a) as being unpatentable over the combination of Kolosov, O'Rear, *The Condensed Chemical Dictionary* and Tolvanen.

The deficiencies of Kolosov et al., O'Rear and *The Condensed Chemical Dictionary* discussed above with respect to the rejection of amended Claim 39, from which Claims 43 depends, apply with equal force to this rejection. Tolvanen does not cure and is not cited as curing the deficiencies of Kolosov et al., O'Rear and *The Condensed Chemical Dictionary*. As pointed out in the Decision on Rehearing, Tolvanen simply discloses a device that determines the stability or storability of oil by measuring the intensity of light scattering from the oil surface after an asphaltene flocculating liquid is added to the oil sample. Thus, Tolvanen is likewise no more relevant a reference than Kolosov et al., O'Rear and *The Condensed Chemical Dictionary*. Specifically, Tolvanen, as with Kolosov et al., O'Rear and *The Condensed Chemical Dictionary*, nowhere discloses or suggests a system for screening lubricant performance, under program control, which comprises, *inter alia*, "c) means for measuring a first storage stability measurement of the lubricating oil composition sample ... wherein the means for measuring the first storage stability measurement is carried out in the absence of heating each lubricating oil

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composition sample ...d) means for measuring a second storage stability measurement of the lubricating oil composition sample moved to the testing station ... wherein the means for measuring the second storage stability measurement is carried out after each lubricating oil composition sample is heated to a predetermined temperature for a predetermined time ... and e) means for comparing said second storage stability measurement to said first storage stability measurement of each lubricating oil composition sample to obtain storage stability data for each sample" as presently recited in amended Claim 39, from which Claim 43 depends. In fact, even by combining Kolosov et al. with O'Rear, *The Condensed Chemical Dictionary* and Tolvanen, one skilled in the art would not even arrive at the presently recited system as set forth in amended Claim 39 from which Claim 43 depends.

Accordingly, Claim 43 is believed to be non-obvious, and therefore patentable, over the combination of Kolosov et al. with O'Rear, *The Condensed Chemical Dictionary* and Tolvanen. Accordingly, withdrawal of the rejection under 35 U.S.C. §103(a) is respectfully requested.

The Board has rejected Claims 44 and 45 under 35 U.S.C. §103(a) as being unpatentable over the combination of Kolosov, O'Rear, *The Condensed Chemical Dictionary* and Garr.

The deficiencies of Kolosov et al., O'Rear and *The Condensed Chemical Dictionary* discussed above with respect to the rejection of amended Claim 39, from which Claims 44 and 45 ultimately depend, apply with equal force to this rejection. Garr does not cure and is not cited as curing the deficiencies of Kolosov et al., O'Rear and *The Condensed Chemical Dictionary*. As pointed out in the Decision on Rehearing, Garr simply discloses a method for producing a large chemical library of products in which the reaction tubes and product are identified by a unique code. Thus, Garr is likewise no more relevant a reference than Kolosov et al., O'Rear and

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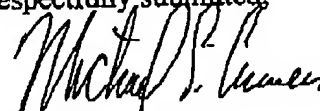
The Condensed Chemical Dictionary. Specifically, Garr, as with Kolosov et al., O'Rear and *The Condensed Chemical Dictionary*, nowhere discloses or suggests a system for screening lubricant performance, under program control, which comprises, *inter alia*, "c) means for measuring a first storage stability measurement of the lubricating oil composition sample ... wherein the means for measuring the first storage stability measurement is carried out in the absence of heating each lubricating oil composition sample ... d) means for measuring a second storage stability measurement of the lubricating oil composition sample moved to the testing station ... wherein the means for measuring the second storage stability measurement is carried out after each lubricating oil composition sample is heated to a predetermined temperature for a predetermined time ... and e) means for comparing said second storage stability measurement to said first storage stability measurement of each lubricating oil composition sample to obtain storage stability data for each sample" as presently recited in amended Claim 39, from which Claims 44 and 45 ultimately depend. In fact, even by combining Kolosov et al. with O'Rear, *The Condensed Chemical Dictionary* and Garr, one skilled in the art would not even arrive at the presently recited system as set forth in amended Claim 39 from which Claims 44 and 45 ultimately depend.

For the foregoing reasons, Claims 44 and 45 is believed to be non-obvious, and therefore patentable, over the combination of Kolosov et al. with O'Rear, *The Condensed Chemical Dictionary* and Garr. Accordingly, withdrawal of the rejection under 35 U.S.C. §103(a) is respectfully requested.

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For the foregoing reasons, Claims 39-45 as presented herein are believed to be in condition for allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,



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